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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,246	03/10/2004	Brian P. Jacob	02420/1200875-US1	3551
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EXAMINER				
SEVERSON, RYAN J				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
08/04/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/798,246

Applicant(s)

JACOB, BRIAN P.

Examiner

RYAN SEVERSON

Art Unit

3731

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16, 18-24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,12-16, 18-24,26,27 and 31 is/are allowed.
- 6) ☒ Claim(s) 28 and 32 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaari (5,599,304) in view of Yarger (5,360,414).**
3. Regarding claims 28 and 32, Shaari discloses a device capable of use for endoluminal protection and access, the device comprising: an access member (1, see at least figure 11) including an outer wall (2) defining an internal lumen, the access member having a longitudinal axis and proximal and distal ends, the distal end being sufficiently blunt to prevent perforation of the gastrointestinal lumen during positioning in the gastrointestinal lumen, an opening (the distal end of the lumen, see figure 11) at the distal end of the access member, wherein the opening intersects the longitudinal axis of the access member, a window (see figure 11, the openings in the wall near the distal end of the tube) that extends through the entire thickness of the outer wall in a radial direction adjacent the distal end of the access member, the outer wall further having a continuous circumference forming an enclosed cylindrical section from the window to the proximal end (see figure 11), the access member having a cross-sectional dimension transverse to the longitudinal axis and a rigidity and a size of the cross-sectional dimension is sufficient to stabilize the gastrointestinal lumen upon positioning

therein to maintain patency of the gastrointestinal lumen, wherein the access member is sufficiently flexible to permit navigation through a tortuous lumen.

4. However, Shaari fails to disclose the window size ranging from 90 to 180 degrees around the axis of the access member. Attention is drawn to Yarger, who shows it is known to make windows at the distal end of an access member with varying size (see column 5, line 53).

5. Further, it has been held that where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). Further still, it has been held that absent persuasive evidence that the particular configuration of the claimed window is significant, a person of ordinary skill in the art would have found it obvious to shape the prior art window in the claimed shape/configuration. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

6. Therefore, in view of the clear suggestion from Yarger that the size of the windows can be controlled, and the case law cited above, Examiner contends one having ordinary skill in the art at the time the invention was made would have found it obvious to have made the windows of Shaari in a size and shape such that they define a radial arc of 90-180 degrees around the circumference of the access member.

Allowable Subject Matter

7. Claims 1, 3, 12-16, 18-24, 26, 27 and 31 are allowed.
8. Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 28 and 32 have been considered but are moot in view of the new grounds of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Severson whose telephone number is (571) 272-4076. The examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:30 p.m.
11. If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, Tom Hughes, at (571) 272-4357.*** The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
12. ***If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to***
TC3700_Workgroup_D_Inquiries@uspto.gov.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J Severson/
Primary Examiner, Art Unit 3731
8/1/11